



IN THE UNITED STATES PATENTS AND TRADEMARK OFFICE

D-1607

Applicant : Masakazu Sueda  
Title : METAL GASKET  
Serial No. : 10/804,070  
Filed : March 19, 2004  
Group Art Unit : 3679  
Examiner : Vishal A. Patel

Hon. Commissioner for Patents  
P.O. Box 1450, Alexandria, VA 22313-1450

May 24, 2006

PETITION UNDER 37 CFR 1.144

Sir:

In the communication of February 14, 2006, it was held that the submission is not fully responsive to the prior Office Action because the amendment introduces non-elected claim language in claims 1, 6, 14, 16 and 19-23. Namely, the Examiner limited the examination to the species shown in Figs. 3 and 4.

In response to the above communication, an amendment was filed on March 2, 2006 according to the Examiner's order, and argument was presented to the Examiner. However, an Office Action was issued on May 2, 2006, and it was held that the restriction is made final.

Background

Claims 1-13 were presented in the original application, wherein claims 1 and 2 are generic; claim 3 is directed to Figs. 7-11; claim 4 is directed to Figs. 7 and 8; claim 5 is directed to

Figs. 7-11; claim 6 is explained in the specification; claims 7-9 are directed to Figs. 1-6; claim 10 is directed to Figs. 1, 2 and 5; claim 11 is directed to Figs. 3 and 4; claim 12 is directed to Figs. 5 and 6; and, claim 13 is explained in the specification.

Claims 1-13 in the original application were examined, and an Office Action was issued on April 19, 2005 without restriction requirement.

In response to the Office Action of April 19, 2005, an amendment was filed on June 30, 2005, wherein claim 7 was canceled, and new claims 14-18 were filed. Thus, claims 1-6 and 8-18 were pending in the application. In the amendment filed on June 30, 2005, claims 1 and 2 are directed to Figs. 1-6; claims 3-5, which should depend from claim 16, are directed to Figs. 7-11, claim 6 is explained in the specification; claim 7 is canceled; claims 8-10 are directed to Figs. 1-6; claim 11 is directed to Figs. 3 and 4; claim 12 is directed to Figs. 5 and 6; claim 13 is explained in the specification; claims 14 and 15 are directed to Figs. 1 and 2; claim 16 is directed to Figs. 7-11; claim 17 is directed to Figs. 9 and 10; and, claim 18 is directed to Fig. 11.

In response to the above amendment, the Office Action was issued on August 30, 2005, wherein no restriction requirement was made. In the Action of August 30, 2005, there was an indication in the Office Action Summary that the Action was made final, but no comment stating the final Action was made in the detailed Action.

Since there was no statement in the detailed Action that the Action was final, in response to the above Action, an amendment was filed on October 30, 2005, wherein claims 2-5, 7-13, 15, 17 and 18 were canceled; claims 1, 14 and 16 were amended; and new claims 19-23 were filed. In the amendment, claim 1 is directed to Figs. 1 and 2; claim 6 is explained in the specification; claim 14 is directed to Fig. 1; claim 16 is directed to Figs. 7 and 8; claim 19 is directed to Fig. 1; claim 20 is explained in the specification;

claim 21 is directed to Figs. 7 and 8; claim 22 is directed to Fig. 7; and claim 23 is explained in the specification.

In response to the above amendment, the Advisory Action was issued on November 9, 2005 and it was deemed that the amendment introduced new issue.

In view of the Advisory Action, RCE was filed on November 21, 2005, wherein it was requested to enter the amendment of October 30, 2005.

In response to the RCE, the communication of February 14, 2006, explained above, was issued.

#### Discussion

As explained above, the original claims cover several embodiments shown in the drawings, and also, the claims in the amendment of June 30, 2005 cover several embodiments. In regard to the original claims and claims amended on June 30, 2005, the Examiner did not issue a restriction requirement. Therefore, the Examiner's opinion stating that "The submission, however, is not fully responsive to the prior Office action because the amendment introduces non-elected claim language in claims 1, 6, 14, 16 and 19-23, which make the amendment non-responsive to the last office action mailed on 7/25/05." as stated in the communication of February 14, 2006 is improper. Incidentally, there is no action mailed on July 25, 2005.

If the Examiner thought that the claims filed on October 30, 2005 contain several species, and the application should be limited to one of the species, the Examiner must issue a restriction requirement. The Examiner can not treat that the amendment is non-responsive.


#### Conclusion

It is, therefore, requested to withdraw the communication of February 14, 2006, and examine the claims filed on October 30, 2005. If the Examiner believes that the invention should be limited to one of the species, a restriction requirement may be issued based on the claims filed on October 30, 2005.

Also, please withdraw the Office Action mailed on May 2, 2006.

If any fee is required, please charge to Deposit Account No. 11-0219.

Respectfully Submitted,

By   
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